



REMARKS

Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 14-36 remain pending in this application.

Rejection Under 35 U.S.C. § 112(1)

Claims 21-36 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

In the Current Action, the Examiner rejects claims 21-36 for failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. Specifically, the Examiner states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. *See* Current Action, paragraph 9. Applicant respectfully submits, however, that the specification as originally filed, enables claims 21-36.

With respect to claims 21, 26, and 31 the Examiner contends that the specification does not teach that “the code retrieved from the device for identifying the type of device is executable code.” *See* Current Action, paragraph 10. However the description of a software element’s function (i.e., identifying the type of device) is considered adequate for enablement by the Federal Circuit and under M.P.E.P. § 2106.01, because one of ordinary skill in the art is capable of writing code to fulfill that function. “As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software . . . [t]his is because, normally, writing code for such software is within the skill of the art.” *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543 (Fed. Cir. 1997). The software function with regard to claims 21, 26, and 31 is sufficiently detailed in the specification to enable its use by one of ordinary skill in the art. (*see* pgs. 7-10). Therefore, Applicant respectfully requests that the 35 U.S.C. § 112 rejection of claims 21, 26, and 31 be withdrawn.

With respect to claim 22 the Examiner states “the specification never refers to a SysObjID.” *See* Current Action, paragraph 11. Applicant respectfully submits that “SysObjID” as recited in claim 22 is enabled by “system object ID” as found in the specification at, for example, pg. 10, line 8 of the patent application as filed and paragraph [0022] of the patent application publication. With respect to claim 30, the Examiner states “Applicant claims using a system object identifier in claim 30,....” *Id.* Applicant respectfully submits that “system object identifier” as recited in claim 30 is enabled by “system object identifier” as found in the specification at, for example, pg. 8 line 26 of the patent application as filed and paragraph [0022] of the patent application publication. Applicant further submits that these limitations are not conflicting, as would be apparent to one of ordinary skill in the art.

With respect to claims 26, 31, and 33, the Examiner states “the specification never defines what the nature of a device is and how it is discovered.” *See* Current Action, paragraph 12. Applicant respectfully submits that “how a device is discovered” is not relevant to patentability. Moreover, Applicant points out that the “nature of the device” is sufficiently clear. For example, claim 26 defines a method for determining the nature of a device associated with an input/output (I/O) path.

With respect to claim 31, the Examiner states “the specification never teaches the existence of multiple code sets.” *See* Current Action, paragraph 13. Applicant points out that claim 31 does not recite “multiple code sets.” In any event, Applicant directs the Examiner’s attention to pgs 9-12 of the specification as filed as enabling claim 31.

With respect to claims 33 and 34, the Examiner states “the specification never discusses how the target device can be identified without regard to the device control protocol or in a plurality of device control protocols.” *See* Current Action, paragraph 14. Applicant directs the Examiner to the specification as filed, particularly at pg. 12, as enabling claims 33 and 34.

Finally, claims 23-25, 27-30, and 32-36 are rejected for including the non-enabled subject matter of the claims from which they depend. In view of the remarks above, that is,

Applicant's arguments regarding the enablement of claims 21, 22, 26, 30, and 31, Applicant submits each of claims 23-25, 27-30, and 32-36 are also enabled.

Rejection Under 35 U.S.C. § 112(2)

Claims 21-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

With respect to claim 21, the Examiner states "it is unclear how a property file designates a code set. In a normal context, a property file is a passive constant that does in itself nothing." *See* Current Action, paragraph 18. As an initial matter, Applicant respectfully disagrees with the Examiner's characterization of "property file." As known in the art, a property file is not necessarily a passive constant that does nothing. The Examiner further opines "the word 'designates' must be read in light of the specification to mean 'is utilized to identify' executable code.... It is doubtful that one of ordinary skill in the art would make such a reading and it is therefore indefinite as to what is intended to be claimed. Applicant further points out that the claimed limitation is sufficiently clear. That is, claim 21 recites a property file that designates a code set for identifying. As would be apparent to one of ordinary skill in the art, the recited property file is capable of designating code used to identify a device.

With respect to claim 26, the Examiner notes "said property file" lacks antecedent basis in the claim. Please note that claim 26 has been amended only for the purpose of correcting this minor informality.

Rejections Under 35 U.S.C. § 103(a)

Claims 14, 15, 17, 21, 23-27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,122,639 to Babu et al. (hereinafter "Babu").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to

combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Without conceding the second criteria has been met, Applicant respectfully asserts that the Examiner fails to establish a prima facie case of obviousness because the Examiner's proposed combination fails to teach or suggest all of the claim limitations.

Claim 14 recites:

calling a specific method, from a plurality of methods, for each created object, wherein said specific method is operable to determine whether a device associated with said I/O path is the type of device described by the property file associated with said object.

In the Current Action, the Examiner points to Babu, at various citations, to satisfy this limitation. *See* Current Action, paragraph 25. However, Babu merely describes "obtaining a device type identifier from the device." (Babu col. 2, lines 64-65). Babu does "[look] up the device type identifier in a device type table stored in the database." (Babu col. 3, lines 8-9). However, this step does not determine whether the device is the type of device described by the property file associated with the object method, as the Examiner contends. When Babu performs this step, the device type has already been determined. In an attempt to cure this defect, the Examiner has argued that elements 302-314 of Babu "retrieve[e] property files from a directory where the property files describes a type of device." Applicant respectfully points out, however, that even if true, such a showing would not meet the elements of the claim. Claim 14 is a method "for discovering a type of device associated with an input/output (I/O) path of a storage area network." Elements 302-314 in Babu could not be used for discovering the type of device because the device type is the very information these steps of Babu use to obtain the device type identifier. Babu does not, therefore, teach or suggest every element of claim 14. Applicant asserts that the Examiner has failed to establish a prima facie case of obviousness and respectfully request that the Appeal Board overrule the rejection of claim 14.

Claim 21 recites

executing said designated code, wherein said designated code set utilizes said retrieved information to determine whether said target device is said device defined by said property file.

In the Current Action, the Examiner points to Babu, at various citations, to satisfy this limitation. *See* Current Action, paragraph 25. However, Babu merely describes “obtaining a device type identifier from the device.” (Babu col. 2, lines 64-65). Babu does “[look] up the device type identifier in a device type table stored in the database.” (Babu col. 3, lines 8-9). However, this step does not determine whether the target device is the device defined by the property file, as the Examiner contends. When Babu performs this step, the device type has already been determined. In an attempt to cure this defect, the Examiner has argued that elements 302-314 of Babu “retrieve[e] property files from a directory where the property files describes a type of device.” Applicant respectfully points out, however, that even if true, such a showing would not meet the elements of the claim. Claim 21 is a method for identifying a device associated with an input/output (I/O) path. Elements 302-314 in Babu could not be used for discovering the type of device because the device type is the very information these steps of Babu use to obtain the device type identifier. Babu does not, therefore, teach or suggest every element of claim 21. Applicant asserts that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully request that the Appeal Board overrule the rejection of claim 21.

Claim 26 recites

executing code associated with a property file, wherein said code is operable to uniquely identify said target device, and operable to determine whether or not said property file defines the nature of said uniquely identified device.

In the Current Action, the Examiner points to Babu, at various citations, to satisfy this limitation. *See* Current Action, paragraph 25. However, Babu merely describes “obtaining a device type identifier from the device.” (Babu col. 2, lines 64-65). Babu does “[look] up the device type identifier in a device type table stored in the database.” (Babu col. 3, lines 8-9). However, this step is not operable to determine whether or not said property file defines the nature of said uniquely identified device, as the Examiner contends. When Babu performs

this step, the device type has already been determined. In an attempt to cure this defect, the Examiner has argued that elements 302-314 of Babu “retrieve[e] property files from a directory where the property files describes a type of device.” Applicant respectfully points out, however, that even if true, such a showing would not meet the elements of the claim. Claim 26 is a method for determining the nature of a device associated with an input/output (I/O) path. Elements 302-314 in Babu could not be used for determining the nature of a device associated with an input/output (I/O) path because the device type is the very information these steps of Babu use to obtain the device type identifier. Babu does not, therefore, teach or suggest every element of claim 26. Applicant asserts that the Examiner has failed to establish a prima facie case of obviousness and respectfully requests that the Appeal Board overrule the rejection of claim 26.

Claims 15, 17, 23-25, 27, and 30 depend from claims 14, 21, and 26, respectively, and inherit every limitation therefrom. As shown above, Babu fails to teach or suggest every limitation of claims 14, 21, and 26. As such, claims 15, 17, 23-25, 27, and 30 set forth limitations not taught or suggested by Babu and are patentable at least by virtue of their dependency from claims 14, 21, and 26. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103 rejection of record.

Claims 16 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Babu in further view of U.S. Patent Application Publication No. US2002/0161852 to Allen et al. (hereinafter “Allen”).

Claims 16 and 29 depend from claims 14 and 26 respectively, and inherit every limitation therefrom. As shown above, Babu fails to teach or suggest every limitation of claims 14 and 26. Moreover, Allen is not relied upon to teach or suggest these missing limitations. As such, claims 16 and 29 set forth limitations not taught or suggested by Babu and Allen and are patentable at least by virtue of their dependency from claims 14 and 26. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103 rejection of record.

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant Admitted Prior Art in view of Babu

Claim 18 recites a system for analyzing input/output paths that includes:

a management server process, wherein said management server process is operable to receive gathered device information from said plurality of host agent processes and from said SNMP manager process; and wherein said management server process is operable to call code identified by property files with gathered device information as arguments to thereby identify types of devices associated with I/O paths of said SAN.

In the Current Action, the Examiner points to Babu, at various citations, to satisfy this limitation. *See* Current Action, paragraph 31. Babu sends “an SNMP Query For a system object identifier to the network . . . and [tests] whether the device is discovered in the network.” (*see* Babu col. 3, lines 47-49). However, this step does not identify types of devices, as the Examiner contends, because when this step is performed in Babu, the device type has already been determined. Moreover, it would be illogical to interpret this “test” step as identifying types of devices, because the type of device “appears to be the very information of Babu uses to perform the “test.” Allen does not teach or suggest this element either, and indeed, the Examiner does not rely on it to do so. The combination of Babu and Allen, therefore, does not teach or suggest every element of claim 18. As such, Applicant asserts that the Examiner has failed to establish a *prima facie* case of obviousness and respectfully requests withdrawal of the rejection of claim 18.

Claim 18 also recites:

a plurality of property files stored in a predefined directory, wherein each property file of said plurality of property files describes a type of device, and wherein each property file of said plurality of property files includes an identifier of code operable to determine whether a device associated with an I/O path is the type of device described by its associated property file

Applicant respectfully asserts that the proposed combination of Babu and AAPA fails to teach or suggest this limitation. In trying to meet this limitation, the Examiner has attempted to equate “property file” with the element 310 of Babu. However, the element 310 is not a “property files” because, among other things: a) element 310 comes from the device itself, not from a predefined directory; and b) element 310 does not appear to contain “code operable to determine whether a device associated with an I/O path.” Although not relied upon to do so, AAPA does not teach this limitation either. Thus, the combination of Babu

and AAPA does not teach or suggest all of the limitations of claim 18. Therefore, the Examiner has failed to establish a prima facie case of obviousness. Applicant respectfully requests withdrawal of the rejection to claim 18.

Claims 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant Admitted Prior Art and Babu in further view of Allen.

Claims 19 and 20 depend from claim 18, and inherit every limitation therefrom. As shown above, Babu and AAPA fail to teach or suggest every limitation of claim 18. Moreover, Allen is not relied upon to teach or suggest these missing limitations. As such, claims 19 and 20 set forth limitations not taught or suggested by the combination of Babu, AAPA, and Allen and are patentable at least by virtue of their dependency from claim 18. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103 rejection of record.

Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004560-1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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